IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	Group Art Unit: 2625
Robert K. Holzwarth, et al	Examiner: Lennin R. Rodriguez
LATE BINDING OF STAMP PAGE CONTENT IN A PRODUCTION DOCUMENT WORKFLOW	Confirmation No. 2751
Serial No. 10/790,534	
Filed 01 March 2004	

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Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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<u>**APPELLANT'S BRIEF ON APPEAL**</u>

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 23-45, which was contained in the Office Action mailed May 28, 2008 .

A timely Notice of Appeal was filed August 27, 2008.

<u>Real Party In Interest</u>

Eastman Kodak Company is the real party in interest.

<u>Related Appeals And Interferences</u>

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

<u>Status Of The Claims</u>

Appendix I provides a clean, double-spaced copy of the claims on appeal.

1. Claims 23-45 are pending in the application.
2. Claims 1-22 are cancelled.
3. No claims are allowed.
4. Claims 23-45 stand finally rejected and are the subject of this appeal.

<u>Status Of Amendments</u>

A set of formal drawings were submitted on August 27, 2008. No other amendments were filed subsequent to the Final Rejection.

<u>Summary of Claimed Subject Matter</u>

A. Independent Claim 23 reads as follows:

23. A printing system for placing content within an electronic document to be printed, the system comprising:

a job preparation station (Fig. 1, elements 104, 106 and 108) for preparing the document (see page 9, line 15 to page 10, line 30) in a first printer ready file format (see the paragraph spanning pages 8 and 9) wherein each page to receive a page number when printed is provided with a flag, tag or marker (see page 19,

lines 9-19), said station including a computer having a memory; said job preparation station including an input device (Fig. 1, element 116) for a user to input the flag, tag or marker in association with each said page to receive a page number; and

said computer having a routine and operative to employ the routine to calculate page numbers and to modify the document into a second printer ready file format (see page 12, lines 16-21) wherein different page numbers are thereby associated with the pages to receive page numbers.

B. Independent claim 34 reads as follows:

34. A method for placing content within an electronic document to be printed, the method comprising:

preparing the document in a first printer ready file format (see page 9, line 15 to page 10, line 30) wherein each page to receive a page number when printed is provided with a flag, tag or marker (see page 19, lines 9-19);

operating a routine in a computer to calculate page numbers in response to the flag, tag or marker and to modify the document into a second printer ready file format (see page 12, lines 16-21) wherein different page numbers are thereby associated with the pages to receive page numbers.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Are claims 23-45 unpatentable as being anticipated by Kremer et al. (US Application 2001/0043365) under 35 U.S.C. 102(b)?

2. Is claim 45 unpatentable under 35 U.S.C. 103(a) as being unpatentable over Kremer et al. in view of Krist et al. (EP 0 478 351 A2)?

3. Are claims 25 and 36 unpatentable under 35 U.S.C. 103(a) as being unpatentable over Kremer et al. in view of Ghobrial et al. (US 2003/007914))?

Arguments

Appellants' invention relates to hard copy output devices, which are hereinafter referred to as "printers" but which include copiers and other devices for producing images from electronic documents. The invention is directed to methods, systems and graphical user interfaces for controlling workflows such that the placement of page numbers is delayed until the document is in a printer-ready file format. As defined in the specification (see page 8 starting at line 25) printer-ready file format is defined as a file format which contains both data to be printed and printer control instructions that can be directly interpreted by an internal processing engine of the printer in order to rasterize the image data onto the output media. Various known file formats meeting this criterion are known and identified in the specification and include documents such as PDF documents.

The present invention provides flexibility in the process of printing page numbers on the pages of the document by including either flags, tags or markers that indicate which pages are going to contain page numbers. The flags, tags or markers are placed inside the printer-ready file format page and stored with the page in memory. At print time, a page number generation module would iterate through the pages of the document, querying whether or not each of the pages is to receive a page number. The correct number would then be applied to the page in the correct locations, and with the correct appearance. Therefore, if a new page or pages were added to a document, if a page or pages were deleted from the document or if a page or pages were moved around (reordered), the page numbering would still be correct. The electronic document with the added page numbers is also provided as a printer-ready file format document having instructions for printing by the printer to allow for reduced processing time for the printing of the document into hardcopy form.

Claims 23-45 are not anticipated by Kremer et al.:

Independent claims 23 and 34 set forth a printing system and a method, respectively, wherein an operator can input a flag, a tag, or a marker to be

associated with each page that is to be printed with a page number. A computer calculates the page numbers and modifies the document so that the proper pages to be printed receive proper page numbers.

The Kremer et al. publication (US 2001/0043365A1) is directed to a printing system capable of inserting tab stock at specific points within a document. Flexibility of printing the tab contents on any one of the tab pages of an ordered set is provided by establishing a flag or marker indicating that a page contains a tab plus the information that needs to be rendered on the tab. The flag or marker is stored in a memory. This facilitates movement of this page around the document or copying of it to a different document. The Examiner suggests that paragraph [0016], lines 1-5 of Kremer et al. discloses that *"each page to receive a page number when printed is provided with a flag, tag or marker,"* the cited passage discloses merely that a flag or marker is used only to indicate that a page contains a tab. Kremer et al. also note that the job preparation station may be provided to add annotations to the document, and that such an annotation may include page numbers. However, there is no teaching of the use of the flag or marker with other pages of the document to permit for calculation of page numbers for the document since the function of the flag or marker is to identify only that a particular page contains a tab. In fact, Kremer et al. are clear that "the final assembly has continuous page numbers added" (paragraph [0027], lines 3-6). If the page numbering is continuous, there is no need for the use of flags or markers to identify those pages that are to have page numbers since there is no provision for pages without page numbers. The Examiner also suggests that paragraph [0030], lines 30-36 disclose that "a job preparation station includes *"an input device for a user to input [a] flag, tag or marker in association with each said page to receive a page number,"* but Appellants dispute that statement.

Claim 45 is patentable under 35 U.S.C. 103(a) over Kremer et al. in view of Krist et al.:

According to the Final Rejection, *"Kremer et al. disclose all the subject matter as described above [in the Office Acton] except wherein in (sic.) the electronic document page numbers are removed from certain pages and the electronic document is reprocessed by recalculating page numbers."* Further

according to the Final Rejection, Krist et al. (EP 0 478 351 A2) teaches the claimed subject method step added by claim 45.

First, Kremer et al. do not disclose all of the claimed subject matter of claim 34. See the previous section of this Brief. Second, the Krist et al. patent is directed to a page numbering system in a printing system that generates page numbers and formats. Krist et al. allow for programming the page numbering format to skip non-document pages (not to number them). One example of a non-document page is a tab stock. According, a combination of the Kremer et al. teaching to identify the location for insertion of tab stock at a flag or marker with the teaching of not numbering tab stock pages Krist et al. would not suggest the use of a flag or marker to identify each page intended to receive a page number.

Claims 25 and 36 are patentable over Kremer et al. in view of Ghobrial et al. under 35 U.S.C. 103(a):

According to the Final Rejection, *"Kremer '365 discloses all the subject matter as described above [in the Office Acton] except wherein the pages of the document in the first printer ready file format are portable and pages of the document in the second printer ready file format are unportable."* Further according to the Final Rejection, Ghobrial '214 teaches the claimed subject method step added by claims 25 and 36.

Kremer et al. do not disclose all of the claimed subject matter of claim 24 and 35. See the previous section of this Brief. Assuming arguendo that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. The primary reference fails to disclose the use of the flag or marker with other pages of the document to permit for calculation of page numbers for the document. Ghobrial et al. fails to disclose the information undisclosed by the primary reference.
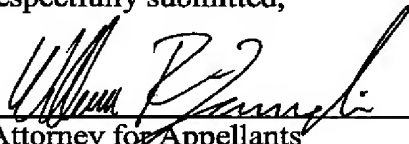
Summary

1. The claims define apparatus that is not taught or rendered obvious by the references of record based on a proper application of 35 U.S.C. 102 or 103.

2. Appellants faced and solved unique problems that were not faced or even
    mentioned in any of the references of record.

3. The rejections of the claims are based on improper reading of the disclosure of
    the references.

Conclusion

For the above reasons, Appellants respectfully request that the Board of
Patent Appeals and Interferences reverse the rejection by the Examiner and
mandate the allowance of Claims 23-45.

Respectfully submitted,

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Enclosures
If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the
Examiner is requested to communicate with Eastman Kodak Company Patent Operations at
(585) 477-4656.

Appendix I - Claims on Appeal

1. – 22. (Canceled).

23. A printing system for placing content within an electronic document to be printed, the system comprising:

a job preparation station for preparing the document in a first printer ready file format wherein each page to receive a page number when printed is provided with a flag, tag or marker, said station including a computer having a memory; said job preparation station including an input device for a user to input the flag, tag or marker in association with each said page to receive a page number; and

said computer having a routine and operative to employ the routine to calculate page numbers and to modify the document into a second printer ready file format wherein different page numbers are thereby associated with the pages to receive page numbers.

24. The printing system according to Claim 23 and wherein the first printer ready file format is as a PDF document and the second printer ready file format is as a PDF document.

25. The printing system according to Claim 24 and wherein the pages of the document in the first printer ready file format are portable and pages of the document in the second printer ready file format are unportable.

26. The printing system according to Claim 24 and wherein the pages of the document in the second printer ready format retain the flag, tag or marker in association with each said page so as to identify that page numbering by the computer operating the routine was used to calculate the different page numbers.

27. The printing system according to Claim 23 and wherein a flag, tag or marker is associated with one or more pages of the electronic document in the first printer ready file format to identify said one more pages as receiving a watermark.

28. The printing system according to Claim 23 and wherein the job preparation station includes a display for reviewing thumbnails of all pages within the document and the user input device allows the user to select those pages that are not to receive a page number and those pages not to receive a page number are provided with a flag, tag or marker.

29. The printing system according to Claim 28 and wherein in a preview mode the thumbnails do not have page numbers displayed.

30. The printing system according to Claim 23 and wherein pages within the document in a first printer ready file format may be moved around the document without introducing page-numbering conflicts.

31. The printing system according to Claim 23 and wherein pages within the document in a first printer ready file format may be moved to a different document without introducing page-numbering conflicts.

32. The printing system according to Claim 23 and wherein a subset of pages of the document to be printed are to be printed on tab stock and at least some pages of the electronic document to be printed on tab stock have associated therewith a respective flag, tag or marker to identify such pages as to have a respective page number printed thereon.

33. The printing system according to Claim 32 and wherein the document to be printed includes pages that are to be printed as duplex pages and other pages to be printed as simplex pages.

34. A method for placing content within an electronic document to be printed, the method comprising:

preparing the document in a first printer ready file format wherein each page to receive a page number when printed is provided with a flag, tag or marker;

operating a routine in a computer to calculate page numbers in response to the flag, tag or marker and to modify the document into a second printer ready file format wherein different page numbers are thereby associated with the pages to receive page numbers.

35. The method according to Claim 34 and wherein the first printer ready file format is as a PDF document and the second printer ready file format is as a PDF document.

36. The method according to Claim 35 and wherein the pages of the document in the first printer ready file format are portable and pages of the document in the second printer ready file format are unportable.

37. The method according to Claim 35 and wherein the pages of the document in the second printer ready format retain the flag, tag or marker in association with each said page so as to identify that page numbering by the computer operating the routine was used to calculate the different page numbers.

38. The method according to Claim 34 and wherein a flag, tag or marker is associated with one or more pages of the electronic document in the first printer ready file format to identify said one more pages as receiving a watermark.

39. The method according to Claim 34 and wherein the job preparation station includes a display for reviewing thumbnails of all pages within the document and the user input device allows the user to select those pages that are not to receive a page number and those pages not to receive a page number are provided with a flag, tag or marker.

40. The method according to Claim 39 and wherein in a preview

mode the thumbnails do not have page numbers displayed.

41. The method according to Claim 34 and wherein pages within the document in a first printer ready file format may be moved around the document without introducing page-numbering conflicts.

42. The method according to Claim 34 and wherein pages within the document in a first printer ready file format may be moved to a different document without introducing page-numbering conflicts.

43. The method according to Claim 34 and wherein a subset of pages of the document to be printed are to be printed on tab stock and at least some pages of the electronic document to be printed on tab stock have associated therewith a respective flag, tag or marker to identify such pages as to have a respective page number printed thereon.

44. The method according to Claim 34 and wherein the document to be printed includes pages that are to be printed as duplex pages and other pages to be printed as simplex pages.

45. The method according to Claim 34 and wherein in the electronic document page numbers are removed from certain pages and the electronic document is reprocessed by recalculating page numbers.

Appendix II - Evidence

None.

Appendix III – Related Proceedings

None.